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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,207	10/28/2003	Anthony J. Beavers	13630.0006	4516
33649	7590	10/25/2005	EXAMINER	
Mr. Christopher John Rourk GODWIN GRUBER, LLP 1201 Elm Street, Renaissance Tower DALLAS, TX 75270			BROCKETTI, JULIE K	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Non-Responsive Amendment**

The reply filed on September 12, 2005 is not fully responsive to the prior Office Action because: Applicant has still not complied with the notice of non-responsive amendment mailed August 11, 2005.

Applicant's amendment filed on April 8, 2005 has not been entered and is not fully responsive to the prior Office action. Applicant cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions). See 37 CFR 1.145.

**§ 1.145 Subsequent presentation of claims for different invention.**

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

Any newly submitted claims that are directed to an invention that is independent and distinct from the invention previously claimed will be withdrawn from consideration and not entered. In this application Applicant cancelled all previous claims and has filed new claims 59-78. The previous claims were directed towards a cheque value system, i.e. "A system for obtaining data for use in a table game system..." The new claims deal with a new invention involving remote terminals in which supervisors can track players including allowing a player to move from a first table game to a second. Applicant has now merely inserted two limitations from the old claims as

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originally filed (cheque value system as recited in the originally filed claims) into these new claims. The overall claims are towards an entirely separate invention, not previously examined.

Newly submitted claims 59-78 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Original claims 13-20 and 36-45, drawn to a cheque value system, classified in class 463, subclass 25.
- II. New claims 59-78, drawn to a remote terminal for use by a supervisor/ a method for monitoring players at a plurality of table games, classified in class 463, subclass 42.

Inventions I (originally filed claims) and II (new claims 59-78) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the remote terminal for use by a supervisor of a gaming area focuses on a player tracking system in which players may move from one gaming table to the other and have their game play tracked. This player tracking/monitoring system does not require the cheque value system as originally claimed since any type of wagering

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monitoring system may be used with claims 59-78. The subcombination has separate utility such as a cheque value data system with specific elements for selection of values and recites nothing about player tracking.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Therefore, for these new claims to be examined, Applicant may file a regular continuation application, not an RCE.

In response to Applicant's arguments filed on September 12, 2005, the Examiner believes she has more clearly clarified the position that the claims are drawn to a different invention. In response to Applicant's arguments that the objective of 37 CFR 1.145 is to ensure that the amended claims in response to an office action do not result in the presentation of claims that would require assignment of the application to a new art unit. The Examiner disagrees. While the assignment to a new art unit may be one reason for not allowing Applicant's to switch inventions, the Examiner notes that through amendments, Applicant can attempt to switch inventions requiring a completely different search even though they are classified in the same art unit as the present Applicant is trying to do. The Examiner completely disagrees

that claim 59 as now presented clearly falls squarely within class 463/29. The claims as now presented relate to a computerized network for tracking player wagering data which is classified in class 463/42 not 463/29. Therefore, contrary to Applicant's assertions, the inventions are within the same class but not the same subclass and as stated above are distinct and independent from each other.

The Examiner does agree that Applicant has taken independent claim 13 from the originally filed claims and has included all of its limitations (as originally filed not as amended) into new claim 59. The Examiner's assertion that Applicant has merely added two limitations from the old claims was based on Applicant's amended claim 13 in which Applicant added other limitations to claim 13, which are not present in claim 59. Nevertheless, the point is that Applicant has taken a subcombination (originally filed claims) and created a combination out of the originally filed claims, which are directed to a distinct and independent invention, which is not allowed in the filing of an RCE.

In regards to Applicant's argument based on the Examiner's example about speakers, the Examiner notes that this was merely an attempt to explain to Applicant how he created a combination/subcombination restriction in his amendment. While the Examiner does agree that the speaker example might have different classifications into different classes based on a speaker and slot machine, she notes that many combination/subcombinations can occur in the same class as in class 463. For example, input devices/controllers (i.e.

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subcombinations) are classified in 463/37 but they may be applied to slot machines which are in 463/20 or even network game systems classified in 463/42. The Examiner notes that there are hundreds of different combinations within class 463 in which both the combination and subcombination of an invention would be in class 463 and a restriction would still be proper based on the fact that inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

The Applicant argues that it is implicit that the Applicant believes that the pending claims include limitations not present in, or obvious in light of the prior art reference and the Examiner's formalistic requirement that Applicant submit arguments why they are patentable over the references is incorrect. The Examiner does note that the requirement to mention support in the specification for the amendments was incorrect; however, as per 37 CFR 1.111(b) Applicant is required to submit arguments why the claims are distinguishable from the prior art references. 37 CFR 1.111(b) states (b)

In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. **The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.** If the reply is with respect to an application, a request may be made that objections

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or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. **A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.**

Therefore, as per the rule, the Applicant is required to specifically state why he believes the new claims are allowable in view of the prior art references.

**Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).**

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julie K Brockett  
Primary Examiner  
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